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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,491	12/28/2001	Ernst Hatz	GRAT 18.983	9655
26304	7590	10/06/2003		EXAMINER
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585				LE, DANG D
			ART UNIT	PAPER NUMBER
			2834	

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/937,491	HATZ ET AL.	
	Examiner Dang D Le	Art Unit 2834	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 July 2003.
 - 2a) This action is **FINAL**. 2b) This action is non-final.
 - 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- Disposition of Claims**
- 4) Claim(s) 1-6 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 - 5) Claim(s) _____ is/are allowed.
 - 6) Claim(s) 1-6 is/are rejected.
 - 7) Claim(s) _____ is/are objected to.
 - 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7/30/03 have been fully considered but they are not persuasive. The applicant's argument is on the ground that "there is no fan wheel shown in Miyakawa, nor is there any consideration given as to the cooling engine or the generator", "one skilled in the art would not be taught or motivated by Takeda et al. to provide a fan wheel in Miyakawa", and "there is a separate flywheel" in Miyakawa reference.

This is not found persuasive because in the art of motor and generator, it is well known that the rotor can be made as a flywheel or the flywheel can be modified to function as a rotor. See Farr (4,203,710), column 3, lines 35-40; Katsumata (4,146,806), column 2, lines 20-65; Gayler (2,963,599), column 2, lines 15-17; Gayler (2,892,109), column 1, lines 55-65; Staak (2,874,309), column 4, lines 25-55; and Harkness et al. (newly found reference 3,828,212), column 3, lines 25-37. Therefore, it would have been obvious to utilize the rotor of Miyakawa as a flywheel. In fact, the rotor of Miyakawa in Figure 2 can work as a flywheel better than the one in Figure 6 because of a larger radius. See Beer et al., pages 499-500.

In addition, heat generated by a motor, a generator, or an engine is also a problem well known in the art of motor and generator. The heat problem can be solved by utilizing a separate fan. See Farr, Figure 1, reference numeral 19 and Scott et al. (5,705,917), Figure 2, reference numeral 240. The heat problem can also be solved by

adding the fan blades to the rotor/flywheel. See Harkness et al., Figure 1, reference numeral 11; Staak, Figure 4, reference numeral 41; and Takeda et al., Figure 11, reference numeral 123. Therefore, it would have been obvious to one having ordinary skill in the art to add the fan blades to the rotor of Miyakawa for the purpose of reducing heat.

In addition, although Takeda et al. do not solve "the cooling problem of its engine", the claims do not clearly and specifically recite the fan wheel rotor used for cooling the engine.

As a result, the rejection is still deemed proper and repeated hereinafter.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is not clear if the applicant really wants to claim "said rotor provided with a stationary winding and permanent magnets" at line 5. The specification only discloses that the rotor is provided with permanent magnets (35) and the stator is provided with a stationary winding (28).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyakawa in view of Takeda et al.

Regarding claim 1, Miyakawa shows all of the limitations of the claimed invention (Figure 1) except for the fan wheel with blades.

Takeda et al. show the rotor made with blades (123) for the purpose of reducing heat.

Since Miyakawa and Takeda et al. are all from the same field of endeavor; the purpose disclosed by one inventor would have been recognized in the pertinent art of the others.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the rotor of Miyakawa as fan wheel with blades as taught by Takeda et al. for the purpose discussed above.

Regarding claims 2-6, it is noted that Miyakawa and Takeda et al. also show all of the limitations of the claimed invention.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information on How to Contact USPTO

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dang D Le whose telephone number is (703) 305-0156. The examiner can normally be reached on Monday through Friday.

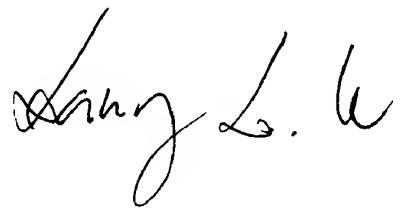
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703) 308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

9/23/03



DANGLE
PRIMARY EXAMINER